

U.S. Patent Application Serial No. 10/677,216
Amendment filed February 22, 2007
Reply to OA dated September 22, 2006

REMARKS

Claims 1 - 24 are canceled without prejudice or disclaimer.

Claims 25 - 34 are currently pending in this patent application, claims 25 and 31 - 34 being independent claims.

Claims 25 and 31 - 34 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicant regards as his invention. The applicant respectfully submits that no new matter has been added. It is believed that this Response is fully responsive to the Office Action dated September 22, 2006.

Claims 25 - 34 are rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in item 5, pages 2 and 3 of the outstanding Office Action. The applicant respectfully requests reconsideration of this rejection.

The Examiner has taken the position that the “‘upper retrieval item information’ and ‘retrieval mode information’ limitations,” as recited in the claims, have no support in the applicant’s specification. It is clear however that such claim limitations can be found in the applicant’s

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specification as “a plurality of units of map information MP, which show maps of the same area with different reduced scales” (see, lines 17 and 18, page 8 of the applicant’s specification as originally filed; and shown in the applicant’s Figure 4), and “the item information of the first layer” (see, lines 8 - 11, page 16 of the applicant’s specification as originally filed) and “retrieval information.”

In view of the above, the withdrawal of the outstanding rejection under 35 U.S.C. §112, first paragraph, is in order, and is therefore respectfully solicited.

Furthermore, claims 25 - 34 are rejected under 35 U.S.C. §112, second paragraph, for the specific reasons discussed in item 7, pages 3 and 4 of the outstanding Office Action. The applicant respectfully requests reconsideration of this rejection.

As indicated above, claims 25 and 31 - 34 have been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicant regards as his invention, and in order to correct certain informalities therein, including those pointed out by the Examiner.

Accordingly, the withdrawal of the outstanding rejection under 35 U.S.C. §112, second paragraph, is in order, and is therefore respectfully solicited.

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Claims 25 - 30, and claim 33 are rejected under 35 U.S.C. §101 because, according to the Examiner, the claimed invention, recited in these claims, is directed to non-statutory subject matter (see, items 9 and 10, pages 4 and 5 of the outstanding Office Action). The applicant respectfully requests reconsideration of this rejection.

The Court of Appeals for the Federal Circuit, in the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn. The patent involved in the *State Street Bank* case, U.S. Patent No. 5,193,056, is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (*e.g.*, in the *State Street Bank* case, which represented “discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price”) constitutes:

- (a) a “practical application of a mathematical algorithm, formula, or calculation,” but
- (b) nevertheless, produces “a useful, concrete and tangible result.”

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According to the current amendments, it has been specified that the information retrieving device and method of the claimed invention include the feature of outputting the desired information (typically, map information). It is submitted that because the claimed invention thus produces the requisite “a useful, concrete and tangible result,” the claimed invention, as recited in the amended claims, is directed to patentable subject matter under 35 U.S.C. §101, pursuant to the *State Street Bank* case.

The fact that claim 33 is directed to a “program” is immaterial provided the claim meets that tests expounded above in the *State Street Bank* case. The applicant submits that claim 33 now recites specific limitations (e.g., the outputting of desired information) that meet such tests.

In view of the above, the withdrawal of the outstanding rejections under 35 U.S.C. §101 is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

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